

REMARKS

Claims 9 and 13 have been amended. Claims 19 and 20 have been canceled. New claims 21-24 have been added. Thus, claims 9-18 and 21-24 are presented for examination. Support for the amendment to claim 9 may be found in the specification at page 9, and at page 10, line 13 to page 11, line 2. Support for the amendments to claims 13 may be found in the specification at page 26, lines 16-25; page 27, lines 7-10; Examples 3-5; page 25, lines 14-15; and page 25, lines 19-20. Support for new claim 21 may be found in the specification at page 25, lines 17-18. Support for new claim 22 may be found in the specification at page 25, line 13. Support for new claim 23 may be found in the specification at page 27, lines 1-6. Support for new claim 24 may be found in the specification at page 12, line 18 to page 14, line 2. Thus, no new matter has been added. Reconsideration and withdrawal of the present rejections in view of the amendments and comments presented herein are respectfully requested.

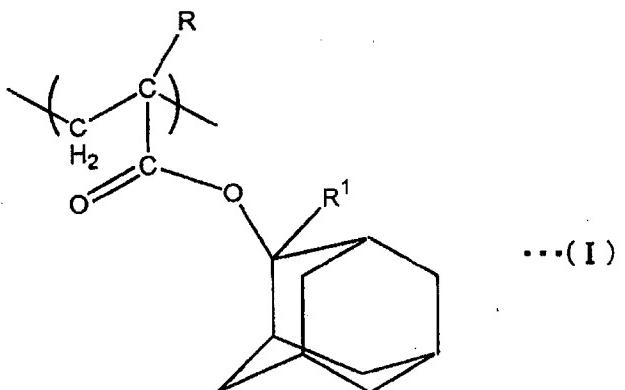
Prior art rejections

The Examiner indicated that "claims 13-18 and 20 are rejected" under 35 U.S.C. §103(a) as unpatentable over US 2001/0014428 of Uetani et al. (Uetani '428) in view of Hatakeyama et al. (US 2002/0207201). However, the body of the rejection refers only to claims 9-12 (see Office Action at section 6, pages 3-7). Moreover, a rejection of claims 13-18 and 20 over these same references in further view of Uetani et al. (US 6,348,297) was set forth. Thus, the Applicants interpret the Office Action as setting forth a rejection of claims 9-12 over Uetani '428 in view of Hatakeyama, and that the second Uetani reference was intended to apply to claims 13-18 and 20..

In addition, Claims 19 and 20 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by, or in the alternative, under 35 U.S.C. § 103(a), as allegedly being obvious over Uetani '428. These claims have been canceled, thereby obviating this rejection

Claim 9 has been amended to recite that "a structural unit (a1) derived from a (meth)acrylate ester containing an acid dissociable, dissolution inhibiting group which is represented by the following general formula (I),

[Formula 2]



[wherein, R represents a hydrogen atom or a methyl group, and R¹ represents a lower alkyl group of 2 to 5 carbon atoms].

Although the Office Action at page 4, lines 6-8, contends that “the α -methacryloyloxy- γ -butyrolactone unit [of Uetani et al.] is equivalent to the [presently claimed] structural unit (a2) derived from a methacrylate ester comprising a lactone-containing monocyclic group” (emphasis added), this is clearly not the case, since (a2) is “a unit derived from a (meth)acrylate ester comprising a lactone-containing polycyclic group”. Thus, the resins recited in amended claim 9 are neither disclosed nor suggested by any of the cited references, either alone or in combination. Thus, the combination of resin component (A) and an acid generator component (B) recited in the amended claim is also neither disclosed nor suggested by any of the cited references. Thus, claim 9 cannot be anticipated or rendered obvious by Uetani et al. alone, or in combination with any of the cited secondary references. Since claims 10-12 depend either directly or indirectly from claim 9, they are also patentable over these references.

However, even if the claims were *prima facie* obvious in view of these references, the claimed invention provides significant unexpected results. The resist compositions recited in present claim 9 unexpectedly exhibit significant reduction in developing defects compared to other resins. The resins recited in amended claim 9 are shown in Examples 1-5 and 9 of the present specification. The resist compositions used in these Examples unexpectedly exhibit developing defects which are smaller by an order of magnitude than those in Examples 6, 7, and 8, which use structural units derived from 2-methyl-2-adamantyl methacrylate and γ -butyrolactone. Such unexpected results could not have been predicted based on the teachings of these references or other knowledge of those having ordinary skill in the art. Thus, the unexpected results would effectively rebut any allegation of *prima facie* obviousness.

In claim 13, the acid generator which is combined with (b-1) “an onium salt-based acid generator comprising a straight-chain fluorinated alkylsulfonate anion of 3 carbon atoms”. This acid generator is neither disclosed nor suggested by any of the cited references, either alone or in combination. In addition, neither the combination of (b-1) and “an onium salt-based acid generator comprising a straight-chain fluorinated alkylsulfonate anion of 3 carbon atoms”, nor the blend ratio of these two components of 1:9 to 9:1, is disclosed or suggested by any of these references. Thus, claim 13, as well as claims 14-18, which depend either directly or indirectly on claim 13, are also patentable over these references.

In view of the comments presented above, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a).

Other comments

The Office Action at page 16, lines 7-9 states that:

As the applicant does not specifically define the terms “alkyl” and “aryl” for the compound (b-1), the claimed compound (b-1) can be represented by a large variety of compounds.

Claim 13 as amended recites “...an aryl group of 6 to 20 carbon atoms or an alkyl group of 1 to 10 carbon atoms,..”. Thus, these terms have now been defined in the claim. The Office Action at page 16, lines 9-12 also states that “the “onium-salt based acid generator comprising a straight chain fluorinated alkylsulfonate anion of 1 to 7 carbon atoms” can be represented by a large variety of compounds, such as alkylsulfonium salts, aromatic sulfonium salts, alkyliodonium salts, aromatic iodonium salts, etc.” Claim 13 as amended recites an onium salt-based acid generator comprising a straight-chain fluorinated alkylsulfonate anion of 3 carbon atoms. An “onium-salt based acid generator comprising a straight chain fluorinated alkylsulfonate anion of 3 carbon atoms” is clearly explained and exemplified in detail in the specification at page 26, lines 17 to page 28.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather,

any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

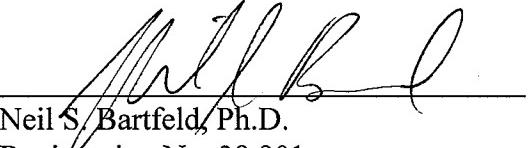
CONCLUSION

Applicants submit that all claims are in condition for allowance. Should there be any questions concerning this application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

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Dated: 6/25/09

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